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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,609	01/17/2001	Donald W. Malackowski	29997/035A	7844

7590

10/03/2002

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EXAMINER

LEUBECKER, JOHN P

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/764,609

Applicant(s)

MALACKOWSKI ET AL.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 35-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,9,10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-34, drawn to a smart instrument, classified in class 606, subclass 1.
  - II. Claims 35-79, drawn to a surgery system, classified in class 600, subclass 424.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed as exemplified by claim 35. The subcombination has separate utility since it can be used by itself.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not exclusively required for Group II, restriction for examination purposes as indicated is proper. To evidence the requirement of "serious burden", it is noted that the application of such requirement affects both search and examination of the claimed patentably distinct inventions. Therefore, as much as the search for the distinct inventions might overlap to a certain extent, there still exists the burden of separate analysis of the prior art references for each distinct invention, as well as a separate written analysis in the Office Action.

4. During a telephone conversation with J. William Frank, III on September 27, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-

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34. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 35-79 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### **DETAILED ACTION**

##### ***Specification***

6. The abstract of the disclosure is objected to because it fails to provide an adequate amount of information. Correction is required. See MPEP § 608.01(b).

##### ***Claim Objections***

7. Claim 29 is objected to because of the following informalities: "button" (line 6) should be "buttons". Appropriate correction is required.

##### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 5, 6, 8, 9 and 13-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Chader et al. (U.S. Pat. 5,617,857).

Chader et al. disclose a housing (32), a plurality of LEDs (20), a transceiver (14), a memory circuit (36), and activation/control buttons (46)(col.7, lines 7-21). Figure 3 shows how the instrument is adapted to be interchangeably coupled to other instruments.

### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4, 7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chader et al.

As to claim 4, Chader et al. fails to disclose a status light. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provided a status light on the Chader et al. device because Applicant has not disclosed that use of a status light provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well without a status light because use of a status light is a mere

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convenience for the user and has no effect on the overall operation of the system. In addition, it is noted that "status lights" are notoriously well known and used in almost every electrical art (e.g., the Examiner's monitor has a status light that indicates that it is on) and use of such a generic feature can not be considered an inventive concept, or can not make a combination of elements novel.

As to claims 7 and 10-12, Chader et al. disclose that a wide variety of medical instruments can be used but fails to specify any particular one. If not inherently covered by the term "medical instruments", it would have been obvious at the time the invention was made to one of ordinary skill in the art to have considered use of any medical instrument typically used in surgical procedures for use with the Chader et al. invention since use of a species of the generic group of medical instruments encompassed by the scope of the Chader et al. device does not constitute an inventive concept.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schulz (U.S. Pat. 5,622,170)

Acker et al. (U.S. Pat. 5,752,513)

Osadchy et al. (U.S. Pat. 6,370,411)

Forrer et al. (U.S. Pat. 6,347,460)

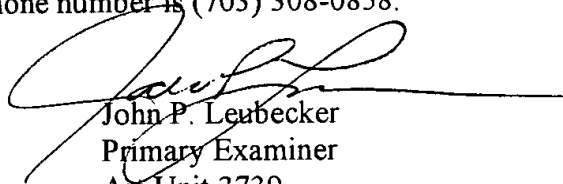
Clayton et al. (U.S. Pat. 6,434,507)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl  
September 28, 2002